



UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D C 2023
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DEC 13 2000

Decision on
Petition for Regrade
Under 37 C.F.R. § 10.7(c)

(petitioner) petitions for regrading her answers to questions 7, 8, 9, 11, 24, 30, 32, 34 and 49 of the morning section and questions 1, 16, 25, 33 and 48 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 65. On July 28, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers.

All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

No credit has been awarded for morning questions 7, 8, 9, 11, 24, 30, 32, 34 and 49 and afternoon questions 1, 16, 25, 33 and 48. Petitioner's arguments for these questions are addressed individually below.

Morning question 7 reads as follows:

7. An application directed to hand shearing of sheep includes the following incomplete independent Claim 1 and dependent Claims 2-3.

Claim 1. An apparatus for shearing sheep, said apparatus comprising:

- (I) a first cutting member having a first cutting edge at one end and a thumb loop at the other end;
- (ii) a second cutting member having a second cutting edge at one end and a finger loop at the other end;
- (iii) _____;
- (iv) said second cutting member additionally including a pointer loop between said finger loop and said mid-point, said pointer loop having a pointer loop center, said finger loop having a finger loop center and said pointer loop having a pointer loop center such that a plane through said finger loop center and said pointer loop center is generally parallel to said second cutting edge for improved balance.

Claim 2. The apparatus of claim 1, wherein said first cutting member includes a threaded aperture extending entirely through said first cutting member between said thumb loop and said mid-point, and an adjusting screw that extends through said threaded aperture to engage a bearing surface below the pointer loop on said second cutting member.

Claim 3. The apparatus of claim 2, wherein said connector is a rivet.

Which of the following most broadly completes missing paragraph (iii) of Claim 1?

(A) "wherein said first cutting member and said second cutting member are pivotally secured to each other at respective mid-points, and wherein said finger loop is padded; and"

(B) "said first cutting member having a mid-point between its ends and said second cutting member having a mid-point between its ends, wherein said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points by a connector; and"

(C) "said first cutting member including a reservoir for dispensing disinfectant solution and having a mid-point between its ends, said second cutting member having a mid-point between its ends, and wherein said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points by a connector; and"

(D) "said first cutting member and said second cutting member being pivotally secured to each other by a connector; and"

(E) "said first cutting member having a mid-point between its ends and said second cutting member having a mid-point between its ends, and said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points; and"

The model answer choice is (B). Answer (B) provides proper antecedent basis for "said mid-point" in part (iv) of Claim 1 and in Claim 2, and "said connector" in Claim 3.

Petitioner argues that (B) is an incorrect answer. Petitioner argues that the question should be thrown out because all the answers are flawed as "a midpoint" occurs twice, referring to two different midpoints, i.e., "a first cutting midpoint" and then "a second cutting midpoint." Since, the claim would be indefinite with any of the answers, petitioner argues that the question should be thrown out.

Petitioner's arguments have been fully considered but they are not persuasive. The instructions state to pick the best answer. Answer (B) does provide proper antecedent basis for both midpoints, "said first cutting member having a mid-point" and "said second cutting member having a mid-point." Answer (C), petitioner's answer is narrower than answer (B) because it includes the additional limitation of a reservoir and therefore does not "most broadly" complete claim 1.

Morning question 8 reads as follows:

8. Applicant received a Final Rejection with a mail date of Tuesday, February 29, 2000. The Final Rejection set a 3 month shortened statutory period for reply. Applicant files an Amendment and a Notice of Appeal on Monday, March 27, 2000. The examiner indicates in an Advisory Action that the Amendment will be entered for appeal purposes, and how the individual rejection(s) set forth in the final Office action will be used to reject any added or amended claim(s). The mail date of the examiner's Advisory Action is Wednesday, May 31, 2000. Which of the following dates is the last date for filing a Brief on Appeal without an extension of time?

- (A) Saturday, May 27, 2000.
- (B) Monday, May 29, 2000 (a Federal holiday, Memorial Day).

- (C) Tuesday, May 30, 2000.
- (D) Wednesday, May 31, 2000.
- (E) Tuesday, August 29, 2000.

The model answer is choice (D). The last date for filing a Brief on Appeal without an extension of time is May 31, 2000.

Petitioner argues that (C) is correct. Petitioner asserts that since the Advisory Action is mailed on May 31, 2000, it is impossible for the practitioner to know that date is available because the practitioner will not receive the Advisory Action until after May 31, 2000. Petitioner further argues that MPEP § 710.02(e) is not available in absence of receipt of an Advisory Action and that since the practitioner could not have received the Advisory Action, she could not have known the Advisory Action date.

Petitioner's arguments have been fully considered but they are not persuasive. As explained in MPEP § 710.02(e), "If an applicant initially replies within 2 months from the date of mailing of any final rejection setting a 3-month shortened statutory period for reply and the Office does not mail an advisory action until after the end of the 3-month shortened statutory period, the period for reply for purposes of determining the amount of any extension fee will be the date on which the Office mails the Advisory Action advising applicant of the status of the application..." Hence, since no extension fee was paid in the fact pattern, the time allowed applicant for reply to the action from which the appeal was taken is the mail date of the Advisory Action, i.e., May 31, 2000. The question is which of the following dates is the last date for filing a Brief on Appeal without an extension of time and the practitioner could have filed the Brief on May 31, 2000.

Morning question 9 reads as follows:

9. A non-final Office action contains, among other things, a restriction requirement between two groups of claims, (Group 1 and Group 2). Which of the following, if included in a timely reply under 37 C.F.R. § 1.111, preserves applicant's right to petition the Commissioner to review the restriction requirement?

I. Applicant's entire reply to the restriction requirement is: "The examiner erred in distinguishing between Group 1 and Group 2, and therefore the restriction requirement is respectfully traversed and no election is being made, in order that applicant's right to petition the Commissioner to review the restriction requirement is preserved."

II. Applicant's entire reply to the restriction requirement is: "Applicant elects Group 1 and respectfully traverses the restriction requirement, because the examiner erred in requiring a restriction between Group 1 and Group 2."

III. Applicant's reply distinctly points out detailed reasons why applicant believes the examiner erred in requiring a restriction between Group 1 and Group 2, and additionally sets forth, "Applicant therefore respectfully traverses the restriction requirement and no election is being made, in order that applicant's right to petition the Commissioner to review the restriction requirement is preserved."

IV. Applicant's reply distinctly points out detailed reasons why applicant believes the examiner erred in requiring a restriction between Group 1 and Group 2, and additionally sets forth, "Applicant therefore respectfully traverses the restriction requirement and elects Group 2."

- (A) I.
- (B) II.
- (C) III.
- (D) IV.
- (E) None of the above.

The model answer is choice (D). Applicant must distinctly point out detailed reasons why he believes the examiner erred in requiring the restriction, traverse the restriction and make an election to respond to a restriction requirement to preserve the right to petition the Commissioner to review the restriction requirement.

Petitioner argues that (E) is correct. Petitioner asserts that choice E is the best answer because choice D does not address the requirement to "to request reconsideration" in order to preserve applicant's right to petition the Commissioner to review the restriction requirement.

See MPEP § 818.03(c) and 37 CFR §§ 1.144 and 1.143. Petitioner further argues that no

definition of "traverse" is provided in the MPEP, patent or patent rules, thus answer (E) is the best choice.

Petitioner's arguments have been fully considered but they are not persuasive.

Applicant's reply distinctly pointing out the error in the restriction requirement inherently includes a request for reconsideration.

Morning question 11 reads as follows:

Please answer questions 10 and 11 based on the following facts. Mario Lepieux was a member of a Canadian national hockey team touring Europe. While traveling through Germany (a WTO member country) in December 1998, Mario conceived of an aerodynamic design for a hockey helmet that offered players improved protection while reducing air resistance during skating. Upon Mario's return to Canada (a NAFTA country), he enlisted his brothers Luigi and Pepe Lepieux to help him market the product under the tradename "Wing Cap." On February 1, 1999, without Mario's knowledge or permission, Luigi anonymously published a promotional article written by Mario and fully disclosing how the Wing Cap was made and used. The promotional article was published in Moose Jaw Monthly, a regional Canadian magazine that is not distributed in the United States. The Wing Cap was first reduced to practice on March 17, 1999. A United States patent application properly naming Mario as the sole inventor was filed September 17, 1999. That application has now been rejected as being anticipated by the Moose Jaw Monthly article.

11. Which of the following statements is most correct?

- (A) In a priority contest against another inventor, Mario can rely on his activities in Canada in establishing a date of invention.
- (B) In a priority contest against another inventor, Mario can rely on his activities in Germany in establishing a date of invention.
- (C) Mario can rely on his activities in Canada in establishing a date of invention prior to publication of the regional Canadian magazine article.
- (D) (A) and (C).
- (E) (A), (B), and (C).

The model answer is choice (E). Mario can rely on his activities in Germany and Canada in establishing a date of invention.

Petitioner argues that (B) is correct. Petitioner asserts that Answer (E) is incorrect because Marion cannot rely on his activities in Canada in establishing a date of invention prior to publication of the regional Canadian magazine article. Petitioner asserts that (C) is incorrect because the reduction to practice occurred after the publication date, therefore Mario cannot rely on his activities in Canada in establishing a date of invention prior to publication of the article.

Petitioner's arguments have been fully considered but they are not persuasive. While the reduction to practice occurred after the date of publication of the article, Mario may rely on his activities in Canada in establishing his date of invention by showing due diligence after conception. See MPEP 715.07. Since the article is a publication of Mario's own work and not a statutory bar, he may rely on his activities in Canada. See 35 U.S.C. § 104; see also MPEP § 715.01(c).

Morning question 24 reads as follows:

24. Which of the following statements is most correct?

(A) Since claim 20 was omitted from the divisional application as filed, it cannot be added to the divisional application by a subsequent Amendment because such an Amendment would constitute new matter.

(B) It was improper to include Tommie and Jo as joint inventors in the parent application.

(C) The examiner may properly make a provisional obviousness-type double patenting rejection in the divisional application based on the parent application, but that rejection may be readily overcome with the filing of a terminal disclaimer.

(D) Because the inventive entity of the amended parent application is different than the inventive entity of the divisional application, the examiner may reject the claims of the divisional application under the provisions of 35 U.S.C. § 102(e).

(E) Statements (A), (B), (C) and (D) are each incorrect.

The model answer is choice (E). None of the statements are correct.

Petitioner argues that (A) is correct. Petitioner asserts that Answer (E) is incorrect because (A) is correct. Petitioner argues that the question is ambiguous because claim 20 is a joint invention, which is typically examined with the composition claims and that there would be no reason to add or incorporate Claim 20 with the divisional application. Petitioner asserts that (A) is correct because rejoinder allows claim 20 to be joined with claims 1-9 and that applicant would not want to incorporate all of the claims in a divisional application.

Petitioner's arguments have been fully considered but they are not persuasive. Answer (A) states "[s]ince claim 20 was omitted from the divisional application as filed, it cannot be added to the divisional application by a subsequent Amendment because such an Amendment would constitute new matter." This statement is incorrect at least because the parent application, which included claim 20, was incorporated by reference. Therefore, adding claim 20 does not constitute the addition of new matter. While claim 20 may have been able to be rejoined with the parent application, the question is which of the following statements is most correct.

Morning question 30 reads as follows:

30. On February 8, 1999, you prepared and filed a patent application for Smith disclosing and claiming a new method for heating automobile windshields. The specification disclosed connecting a variable voltage source to a resistive heating element, connecting the heating element to the windshield, and adjusting the voltage of the voltage source to an effective amount. The specification stated certain advantages of heating automobile windshields by the invention's method, including protecting the internal structure of the glass from cracking, and defrosting the glass. The specification also fully disclosed guidelines adequately explaining that an effective amount of voltage to protect windshield glass from cracking was at least 0.5 volts, regardless of the outside temperature. The specification disclosed that an effective amount of voltage for defrosting windshields was at least 1.0 volt, regardless of the outside temperature. Claim 1 stated the following:

Claim 1. A method for heating an automobile windshield, comprising: connecting a variable voltage source to a resistive heating element; connecting the resistive heating element to the automobile windshield; and adjusting the voltage source to an effective amount of voltage.

You received a non-final Office action, dated February 4, 2000, rejecting claim 1 only under 35 U.S.C. § 112, second paragraph. The rejection stated that the use of the limitation, "an effective amount of voltage," rendered the claim indefinite. Which, if any, of the following actions, taken by you, comport with proper PTO rules and procedure, and will overcome the rejection?

I. Filing an appeal with a brief, on August 3, 2000, arguing that the only remaining issue is the definiteness of claim 1, and that the claim is not rendered indefinite by the use of the limitation, "an effective amount of voltage," since guidelines in the specification fully disclosed what "an effective voltage" would be.

II. Filing a reply on May 4, 2000, traversing the rejection on the grounds that claim 1 is not rendered indefinite by the use of the limitation, "an effective amount of voltage," since guidelines in the specification fully disclosed what "an effective voltage" would be.

III. Filing a reply on May 4, 2000, amending the limitation, "an effective amount of voltage" to read, "an effective amount of voltage for defrosting the automobile windshield".

- (A) I.
- (B) II.
- (C) III.
- (D) II and III.
- (E) I, II, and III.

The model answer is choice is (C). A reply amending the limitation "an effective amount of voltage" to read, "an effective amount of voltage for defrosting the automobile windshield" would comport with proper PTO rules and procedure, and will overcome the rejection.

Petitioner argues that answer (D) is correct. Petitioner asserts that parts (II) and (III) are both correct answers making answer (D) the correct answer. Petitioner argues that the claim is directed to a method of heating an automobile windshield, thus one skilled in the art would know according to the disclosure the effective amount required for heating the windshield. Petitioner further asserts that the rejection may be overcome by pointing out the specification fully

discloses what an effective amount means. Petitioner argues that *In re Frederiksen*, 213 F.2d

547, 102 USPQ 35, 36 (CCPA 1954), does not apply, because the specification supplies the

guidelines. Petitioner further asserts that *In re Watson*, 517 F.2d 465, 186 USPQ (BNA 11

(CCPA 1975), a subsequent decision should rule and in *Watson* the court decided applicant was not required to specify the function to be achieved.

Petitioner's arguments have been fully considered but they are not persuasive. Answer (C) includes choice II, which is incorrect because the phrase "an effective amount of voltage" has two different functions, i.e., to "protect windshield glass from cracking" and "for defrosting windshields." See § 2173.05(c), section III. A claim has been held to be indefinite when the claim, as in this case, fails to state which of two disclosed functions is to be achieved. It is not clear which function is related to the phrase in the claim. In this instance, it is not clear which of the two functions "an effective amount" is addressing. *Watson* is not applicable because there was only one function.

Morning question 32 reads as follows:

32. Nonobviousness of a claimed invention may be demonstrated by:

- (A) producing evidence that all the beneficial results are expected based on the teachings of the prior art references.
- (B) producing evidence of the absence of a property the claimed invention would be expected to possess based on the teachings of the prior art.
- (C) producing evidence showing that unexpected results occur over less than the entire claimed range.
- (D) producing evidence showing that the unexpected properties of a claimed invention have a significance less than equal to the expected properties.
- (E) (A), (B), (C) and (D).

The model answer is choice is (B). Nonobviousness may be demonstrated by producing evidence of the absence of a property the claimed invention would be expected to possess based on the teachings of the prior art.

Petitioner argues that answer (C) is also correct. Petitioner asserts that question 32 is inherently ambiguous because it is capable of two interpretations. Petitioner argues that "less than the entire claimed range is not the equivalent to "commensurate in scope with claimed invention." Petitioner also cites MPEP 716.02(d) "the nonobviousness of a broader claimed range can be supported by evidence based on unexpected results from testing a narrower range if one of ordinary skill in the art would be able to determine a trend in the exemplified data which would allow the artisan to reasonably extend the probative value thereof."

Petitioner's arguments have been fully considered but they are not persuasive. Answer (C) is incorrect because petitioner is assuming additional facts that are not given in the question, specifically, "one of ordinary skill in the art would be able to determine a trend in the exemplified data which would allow the artisan to reasonably extend the probative value thereof", thus the citation is inapplicable. See MPEP 716.02(d). Furthermore, the instructions state not assume any additional facts not presented in the questions. The question is what may demonstrate nonobviousness of a claimed invention and B is the only correct answer.

Morning question 34 reads as follows:

34. You have just received an Office action rejecting all of your claims in your patent application as anticipated under 35 U.S.C. § 102(a) using published declassified material as the reference. The examiner explains that the declassified material is being used as *prima facie* evidence of prior knowledge as of the printing date. The published declassified material contains information showing that it was printed six months before the filing date of the application, and that it was published two months after the application's filing date. You correctly note that although the printing date precedes your application filing date by six months, you note that the publication was classified as of its printing date (thus, available only for limited distribution even when the application was filed), and was not declassified until its publication date (when it became available to the general public). Each element of the claimed invention is described in the publication of the declassified material. Which of the following statements is **true**?

(A) The rejection is not supported by the reference.

(B) The publication is not available as a reference because it did not become available to the general public until after the filing date of your patent application.

(C) The publication is *prima facie* evidence of prior knowledge even though it was available only for limited distribution as of its printing date.

(D) The publication constitutes an absolute statutory bar.

(E) It is not possible to use a Rule 131 affidavit or declaration to antedate the printing date of the publication.

The model answer is choice is (C). The publication is available as a prior art as of its printing date.

Petitioner argues that answer (B) is correct. Petitioner argues that the publication is not *prima facie* evidence because the MPEP clearly states that “may” not that it “is” evidence of a *prima facie* case of prior knowledge. Petitioner further argues that there is evidence that applicant made the invention and only disclosed it to others.

Petitioner’s arguments have been fully considered but they are not persuasive. Petitioner’s arguments assume additional facts not presented in the question. There is no evidence that this is a disclosure of applicant’s invention. The MPEP states “declassified material may be taken as *prima facie* evidence of such prior knowledge as of its printing date even though such material was classified at that time,” so clearly, this evidence is present. See MPEP § 707.05(f). Since the publication may be a reference, it is clearly incorrect to state that the “publication is not available as a reference because it did not become available to the public until after the filing date of your patent application.” Choice B is not the most correct answer, because the publication is available as a reference.

Morning question 49 reads as follows:

49. Which of the following statements is NOT true?

(A) In representation of a client, a patent practitioner may not refuse a client's request that the practitioner aid or participate in conduct that the practitioner believes to be unlawful so long as there is some support for an argument that the conduct is legal.

(B) A patent practitioner may not form a partnership with a non-practitioner if any of the activities of the partnership consists of the practice of patent law before the PTO.

(C) In a patent case, a practitioner may take an interest in the patent as part or all of his or her fee.

(D) If a practitioner receives information clearly establishing that a client has, in the course of representation, perpetrated a fraud on the PTO that the client refuses or is unable to reveal, the practitioner must reveal the fraud to the PTO.

(E) A patent practitioner may not accept compensation from a friend of a client for legal services performed by the practitioner for the client, unless the client consents after full disclosure.

The model answer is choice is (A). A patent practitioner may refuse a client's request that the practitioner aid or participate in conduct that the practitioner believes to be unlawful, even though is some support for an argument that the conduct is legal. See 37 C.F.R. §

10.84(b)(2)

Petitioner argues that answer (B) is correct. Petitioner submits that 37 C.F.R. § 10.49 can reasonably be interpreted to support Petitioner's belief that answer B is in accord with PTO policy and procedure. Petitioner interprets the statement in answer B as "a practitioner may not form a partnership with a non-practitioner **only** in the area of patent law." Therefore, petitioner concludes that the statement is not true because a practitioner may not form a partnership with a non-practitioner if the activities also include trademark or other law before the Office under 37 CFR 10.49.

Petitioner's arguments have been fully considered but they are not persuasive. Petitioner mis-interprets the statement in answer B and assumes additional facts that are not presented, specifically, "**only** in the area of patent law." Accordingly, answer B is incorrect because the

statement is true. The question is which statement is false, not true, thus answer A is the correct answer.

Afternoon question 1 reads as follows:

1. Which of the following does not constitute probative evidence of commercial success to support a contention of non-obviousness?

- (A) In a utility case, gross sales figures accompanied by evidence as to market share.
- (B) In a utility case, gross sales figures accompanied by evidence as to the time period during which the product was sold.
- (C) In a utility case, gross sales figures accompanied by evidence as to what sales would normally be expected in the market.
- (D) In a utility case, gross sales figures accompanied by evidence of brand name recognition.
- (E) In a design case, evidence of commercial success clearly attributable to the design, and not to improved performance of the device.

The model answer is choice is (D). In a utility case, gross sales figures accompanied by evidence of brand name recognition does not constitute probative evidence of commercial success to support a contention of non-obviousness.

Petitioner selected answer (B). Petitioner argues that due to the defective nature of the question that question 1 should be eliminated from the exam. Petitioner argues that except for choice E, none of the answer choices are truly probative as recited. Petitioner argues that the MPEP does not discuss a logical standard with respect to commercial success. Petitioner asserts that "brand name recognition" provides no more or less a logical standard for the determination of commercial success than "market share," "time period" or "expected sales". Petitioner argues whether or not answers A-D are probative would depend on that evidence supplied.

Petitioner's arguments have been fully considered but they are not persuasive. The instructions state that test taker is to select the most correct answer. Petitioner quotes the MPEP

§ 716.01(c) which states “[i]n considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising . . .”

These factors are directly related to brand name recognition, thus choice D is not probative evidence of commercial success.

Afternoon question 16 reads as follows:

Please answer questions 16 and 17 based on the following facts. On February 15, 1999, Debbie conceived a unique system for humanely caging hunting dogs and automatically feeding them at appropriate times. Debbie told her husband, Ted, about her idea that night, and the two spent the next four months working regularly on the concept. Ted built a cage that implemented the concept on June 17, 1999, and tested it on his own dogs for a week. It worked perfectly for its intended purpose. The next day, Ted visited a family friend, Ginny, who happened to be a registered practitioner, and asked her to prepare a patent application on Debbie's behalf. Ginny declined representation, explaining that she was in the middle of trial preparation and would not be able to work on the application for at least four months. Ginny gave Ted the names of a number of qualified patent practitioners, suggesting he consider retaining one of them to promptly prepare the patent application, and explained that a delay in filing the patent application could prejudice Debbie's patent rights. Ted, however, felt uncomfortable going to a practitioner he did not know personally, and did not contact any of the individuals recommended by Ginny. After Ginny had completed her trial and was back in the office, Ted visited her on December 1, 1999. At that time Ginny agreed to represent Debbie. An application was filed in the PTO within 10 days.

On May 15, 1999, Billie conceived an idea substantively identical to Debbie's. Billie immediately prepared a detailed technical description including drawings and visited a registered practitioner. Billie filed a patent application on June 14, 1999. Later, on July 9, 1999, Billie built a cage that implemented the concept and had fully tested it by August 11, 1999.

16. Assuming Debbie's patent application is substantively identical to Billie's patent application, which of the following statements is most correct?

(A) Nearly simultaneous invention by Debbie and Billie is proof that the invention is obvious and precludes patentability.

(B) Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.

(C) Nearly simultaneous invention by Debbie and Billie may be evidence of a long-felt need for the invention.

(D) Nearly simultaneous invention by Debbie and Billie may be evidence of commercial success of the invention.

(E) Statements (A), (B), (C) and (D) are each incorrect.

The model answer is choice is (B). Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.

Petitioner selected answer (C). Petitioner asserts that *In re Merck & Co.*, 231 USPQ 375 (Fed. Cir. 1986), cited by the PTO in support of answer (B) does not address simultaneous inventions and the level of skill in the art. Petitioner further argues that since the MPEP, U.S. patent statutes, patent rules, and the case law provided on the PTO answer sheet do not address simultaneous invention that question 16 should be eliminated from the exam.

Petitioner's arguments have been fully considered but they are not persuasive. Statement (C) is incorrect because nearly simultaneous invention does not bear on long-felt need. Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention. See *The International Glass Company, Inc. v. United States*, 159 USPQ 434, 442 (US Cl.Ct, 1968).

Afternoon question 25 reads as follows:

25. You filed a patent application on behalf of Smith, an employee of Fix Corporation. The application contains a power of attorney authorizing you to transact all business before the Office on behalf of Smith. After the application is filed, Smith assigns all rights in the application to Fix Corp. In which of the following situations will the power of attorney granted to you be properly revoked?

I. Joe, in-house corporate counsel at Fix Corp., but not an officer of Fix, signs a submission, pursuant to 37 C.F.R. 3.73(b), establishing ownership of the entire interest in the application by Fix Corp., and forwards the submission along with a revocation of the power of

attorney granted to you, to the PTO. Joe is not a registered practitioner, and he has not been authorized to bind Fix Corp.

II. Smith refuses to revoke the power of attorney given to you, but Snix, president of Fix Corp., signs a submission, pursuant to 37 C.F.R. 3.73(b), establishing ownership of the entire interest in the application by Fix Corp., and forwards the submission along with a Snix-signed revocation of the power of attorney granted to you, to the PTO.

III. Joe, in-house corporate counsel at Fix Corp., advises Snix, president of Fix Corp., that the assignment by Smith to Fix Corp. automatically operates as a revocation of the power of attorney granted to you, and Snix relies upon Joe's advice in good faith and takes no further action toward revoking the power of attorney. Joe is not a registered practitioner, and he has not been authorized to bind Fix Corp.

- (A) I.
- (B) II.
- (C) III.
- (D) I and II.
- (E) None of the above.

The model answer is choice is (B). Smith refuses to revoke the power of attorney given to you, but Snix, president of Fix Corp., signs a submission, pursuant to 37 C.F.R. 3.73(b), establishing ownership of the entire interest in the application by Fix Corp., and forwards the submission along with a Snix-signed revocation of the power of attorney granted to you, to the PTO.

Petitioner selected answer (D). Petitioner argues that binding a corporation is a matter of applicable state law and that a corporate counsel may therefore have the inherent power to revoke the Power of Attorney. Petitioner asserts that since the exam is supposed to test applicant's knowledge of patent law and U.S. Patent and Trademark Office rules, practice and procedure that this question should be eliminated from the exam.

Petitioner's arguments have been fully considered but they are not persuasive. The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization – an officer. In (B), the submission is signed by the President, an

office having apparent authority. See MPEP 324 and 402.07. Answer (D) is incorrect because it include statement I which states that Joe, the in-house corporate counsel, has not been authorized to bind Fix Corp.

Afternoon question 33 reads as follows:

33. A claim limitation reads “having 10 to 20 grams of iron, preferably 13-18 grams of iron.” The specification preceding the claim supports not only the limitation, but also the broader amounts of iron. Which of the following statements is correct?

- (A) The limitation may be indefinite.
- (B) Since the limitation properly sets forth outer limits, it is definite.
- (C) As long as the limitation is supported in the written description, it is proper.
- (D) The limitation is definite since the limitation sets forth a preferred range.
- (E) The applicant, having set forth a limitation in the claim, i.e., a range of 10 to 20 grams, is precluded by the doctrine of equivalents from expanding the claim coverage beyond the 10 to 20 grams of iron.

The model answer is choice is (A). A limitation which reads “having 10 to 20 grams of iron, preferably 13-18 grams of iron” may be indefinite.

Petitioner selected answer (C). Petitioner argues that choice (C) is the best answer because the claim is supported in the specification and is proper as to the written description requirement.

Petitioner’s arguments have been fully considered but they are not persuasive. The claim is indefinite under 35 U.S.C. § 112, **second** paragraph. **MPEP § 2173.05(c)** indicates that a preferred narrower range set forth within a broader range may render the claim indefinite if the boundaries of the claim are not discernable.

Afternoon question 48 reads as follows:

48. Which of the following statements regarding 35 U.S.C. § 103 is most correct?

(A) PTO classification of prior art references used to reject a claim under 35 U.S.C. § 103, and the similarities and differences in structure and function carry equal weight as evidence of whether the references are analogous or non-analogous.

(B) The question of obviousness under 35 U.S.C. § 103 is resolved by determining whether the differences between the prior art and the claims would have been obvious.

(C) Obviousness of an invention can be properly determined by identifying the "gist" of the invention, even where the "gist" does not take into regard an express limitation in the claims.

(D) In delineating the invention, consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are inherent in the subject matter and disclosed in the specification.

(E) Obviousness can be predicated on what is not known at the time an invention is made, where the inherency of the feature is later established.

The model answer is choice is (D). With respect 35 U.S.C. § 103, in delineating the invention, consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are inherent in the subject matter and disclosed in the specification.

Petitioner selected answer (B). Petitioner argues that the question is ambiguous and that none of the answers are completely correct. Petitioner argues that choice (D) does not address looking at the invention as a whole.

Petitioner's arguments have been fully considered but they are not persuasive. "In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question...but also to those properties of the subject matter which are inherent in the subject matter *and* are disclosed in the specification..." *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977); MPEP 2141.02 (section styled, "Disclosed Inherent Properties Art Part of 'As A Whole' Inquiry"). While the answer choice does not state invention as a whole, the choice is the best answer. Regarding choice (B), the question under 35 U.S.C. § 103 is whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v.*

Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). (C) is incorrect. MPEP 2141.02 (section styled, "Distilling The Invention Down To a 'Gist' or 'Thrust' Of An Invention Disregards 'As A Whole' Requirement"). *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987), *cert. denied*, 481 U.S. 1052 (1987) (district court improperly distilled claims down to a one word solution to a problem) MPEP 2141.02

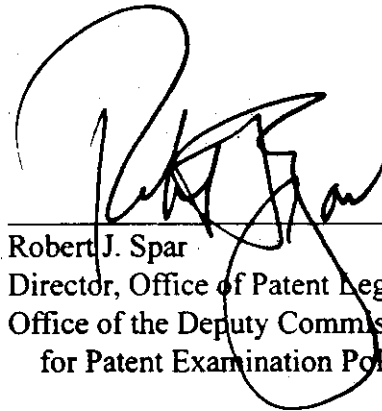
No error in grading has been shown as to morning questions 7, 8, 9, 11, 24, 30, 32, 34 and 49 and afternoon questions 1, 16, 25, 33 and 48. Petitioner's request for credit on these questions is denied.

ORDER

For the reasons given above, no point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 65. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy